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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,930	07/17/2003	Susann Marie Keohane	AUS920030357US1	2228
7590 11/10/2008 BARRY S. NEWBERGER WINSTEAD SECHREST & MINICK P.C. P.O. BOX 50784 1201 MAIN STREET DALLAS, TX 75250-0784				
EXAMINER HUSSAIN, TAUQIR				
ART UNIT 2452		PAPER NUMBER		
MAIL DATE 11/10/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/621,930

Applicant(s)

KEOHANE ET AL.

Examiner

TAUQIR HUSSAIN

Art Unit

2452

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 10 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 10 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to amendment /reconsideration filed on 08/20/2008, the amendment/reconsideration has been considered. Claims 3, 10 and 17 have been added. Claims 3, 10 and 17 are pending for examination, the rejection cited as stated below.

Response to Arguments

2. Applicant's arguments have been fully considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 10 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Xue et al. (Patent No.: US 6,782,414 B1), hereinafter "Xue" in view of Shono et al. (Pub. No.: US 20030084110 A1), hereinafter "Shono".

5. As to claim 3, 10 and 17 (product, method, system etc.) Xue discloses, if a failed delivery e-mail message is received, setting in an entry in one of an address book, an address database an indicator associated with an address of an addressee corresponding to the failed delivery message (Xue, Fig.8D, Element-828,834 and 842,

Co1.12, lines 42-60, where stop icon is associated with failed delivery messages corresponding to the failed email delivery addresses and Col.13, lines 40-44, where Xue discloses to mark the intended recipient with a failed status which means making an entry into recipient address which is a part of address book and address book is part of the database); and

displaying said address in conjunction with a perceptive cue in response to said indicator being set (Xue, Fig.5 and Fig.8D, Element-828,834 and 842, Co1.12, lines 42-60, where stop icon is associated with failed delivery messages corresponding to the failed email delivery addresses and messages are still waiting to be delivered);

wherein, if said indicator is set (Xue, Fig.8D, Element-828,834 and 842, Co1.12, lines 42-60, where stop icon is associated with failed delivery messages corresponding to the failed email delivery addresses), said indicator is operable for clearing in response to said address becoming accessible (Xue, Fig.3, Elements 303-306 Col. 8, lines 30-37, where 304 is reconciled module means if address matches than in next step indicator or status gets updated); and

clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message (Xue, Fig.3, Elements 301-306, Col.8, lines 38-57, where at step-305 status gets updated after address becomes accessible or reconciled).

Xue however is silent on disclosing explicitly, an address cache.

Shono however discloses explicitly, an address cache (Shono, [0043], where email addresses are stored temporarily in RAM 203 with the list of the email addresses registered in the address book 216).

Therefore it would have been obvious to one of the ordinary skilled in the art at the time the invention was made to combine the teachings of Xue with the teachings of Shono to provide an E-mail printing apparatus having excellent operability which can prevent a situation such that E-mail such as spam mail or the like with contents which the user of the printing apparatus does not desire is sent to the printing apparatus and print which the user does not desire is executed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAUQIR HUSSAIN whose telephone number is (571)270-1247. The examiner can normally be reached on 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571 272 3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. H. /
Examiner, Art Unit 2452

/Kenny S Lin/
Primary Examiner, Art Unit 2452